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| EXAMINER |
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HUNTSINGER, PETER K

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| ART UNIT | PAPER NUMBER |
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2625

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08/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/609,369

Applicant(s)

MIMA, TSUYOSHI

Examiner

Peter K. Huntsinger

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/18/08 have been fully considered but they are not persuasive.

The applicant argues on page 6 of the response in essence that:

Parry '863 does not disclose setting a destination for the original image of the document to an address of the user authenticated by the authentication means.

a. Parry '863 discloses in Block 170 of Fig. 2 that the printer, at which the user is present, retrieves the requested document (col. 4, lines 35-46). The user is considered at the printer because Parry '863 discloses that the user is given the opportunity to make the print format selections at the printer (col. 4, lines 35-46). Therefore, the address of the printer can be considered the address of the user.

The applicant argues on page 7 of the response in essence that:

Since claim 4 does not refer to transmitting scanned images, the cited portion of the applicant's specification is not an admission of anything contained in claim 4.

b. The background section of an applicant's specification constitutes admitted prior art. The applicant's background section teaches that in transmitting a document, the image is generally attached to an E-mail and then transmitted (page 1, lines 23-27). Parry '863 discloses the original image (col. 4, lines 29-36, printer retrieves request document). In response to applicant's

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arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Parry '863.

Referring to **claim 1**, Parry '863 discloses an image processing apparatus (Printer 10 of Fig. 1, col. 3, lines 8-11), comprising:

read means for reading an image on a document that contains image storage information representing a location where an original image of the documents is stored (Block 130 of Fig. 2, col. 3-4, lines 65-67, 1-9, detects barcode containing URL);

authentication means for authenticating whether a user can utilize an original image of the document (col. 4, lines 9-12, PIN number used to verify authorization to access the remote URL);

search means for searching the original image of the document from an image storage device which stores the original image of the document, on the basis of the image storage information when the user is authenticated by said authentication means (col. 4, lines 29-36, printer retrieves request document);

setting means for automatically setting, in accordance with an authentication by said authentication means, a destination for an original image of a document to an address of the user authenticated by the authentication means (Block 170 of Fig. 2, col. 4, lines 35-46, printer at which the user is present retrieves the request document, user is given the opportunity to make selections [i.e. user is at the printer]); and

output means for outputting the original image of the document searched by said search means to the destination set by said setting means (Block 170 of Fig. 2, col. 4, lines 35-36, printer retrieves request document).

Referring to **claim 2**, Parry '863 discloses wherein the image storage information includes information represented by a barcode (Block 130 of Fig. 2, col. 3-4, lines 65-67, 1-9, detects barcode containing URL).

Referring to **claim 3**, Parry '863 discloses where the image storage device includes a server device connected via a network (col. 3, lines 33-37, accesses remote device 70 by means of network).

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Referring to **claim 5**, Parry '863 discloses means for causing a printing device to print the image storage information, and causing the image storage device to store the original image of the document (Block 220 of Fig. 2, col. 4, lines 53-55, document is printed).

Referring to **claim 7**, see the rejection of claim 1 above.

Referring to **claim 9**, see the rejection of claim 1 above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parry '863 as applied to claim 1 above, and further in view of applicant's admitted prior art.

Referring to **claim 4**, Parry '863 discloses outputting the original image to the destination set by said setting means but does not disclose expressly attaching the original image to an e-mail and outputting the e-mail.

The applicant's admitted art teaches wherein output means attaches the original image to E-mail, and outputs the E-mail with the original image (page 1, lines 23-27). At the time of the invention, it would have obvious to a person of ordinary skill in the art to email a scanned image to a server. The motivation for doing so would have been to send the image to a central location for long-term storage. Therefore, it would have

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been obvious to combine the applicant's admitted prior art with Parry '863 to obtain the invention as specified in claim 4.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parry '863 as applied to claim 1 above, and further in view of Mori '590.

Referring to **claim 6**, Parry '863 discloses where said output means outputs the original image but does not disclose expressly outputting the image without the image storage information.

Mori '590 discloses outputting an original image without the image storage information (col. 4, lines 15-20, identification code is not printed on the document or print image itself).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to print an original image without the URL barcode. The motivation for doing so would have been to produce a document free of distracting/unwanted marks.

Therefore, it would have been obvious to combine Mori '590 with Parry '863 to obtain the invention as specified in claim 6.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625